

REMARKS

This paper responds to the Final Office Action dated September 28, 2009. Claims 1, 3, and 14 are amended herein. Claims 2, 4-6, 10, and 12-13 were previously canceled, and claims 18-21 are added herein. As a result, claims 1-3, 7-9, 11, and 14- 21 are now pending in this application.

New Claims

Claims 18-21 are added herein. Each of claims 18-21 depend from independent method claim 1 and thus are directed to a method. Applicants aver that no new matter has been added and that all claimed elements are supported by Applicants' specification.

Moreover, the elements recited in method claims 18-21 respectively correspond to elements previously presented and examined in claims 7-9 and 11, which depend from independent claim 3 and thus are directed to a device. Thus, Applicants respectfully request that claims 18-21 be entered, considered, and allowed.

§ 101 Rejections of the Claims

Claims 3, 7-9, and 14-17 were rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. Independent claim 3 is expressed using "means-plus-function" language and thus should be examined under 35 U.S.C. § 112, sixth paragraph.¹ With respect to claim 3, the Office Action stated that "the claimed device may be reasonably considered as a

¹ "A claim limitation will be **presumed** to invoke 35 U.S.C. 112, **sixth** paragraph, if it meets the following 3-prong analysis:

- (A) the claim limitations must use the phrase "**means for**" or "step for;"
- (B) the "**means for**" or "step for" must be modified by functional language; and
- (C) the phrase "**means for**" or "step for" **must not be modified by sufficient structure**, material, or acts for achieving the specified function." MPEP 2181(I), paragraph 2, emphasis added.

software device, and a software device does not meet one of the four categories of invention and is nonstatutory.”²

According to the MPEP, “USPTO personnel should determine whether [a] **computer program** is being claimed as part of an otherwise statutory manufacture or machine. In such a case, the claim remains statutory irrespective of the fact that a computer program is included in the claim.”³ “When a computer program is recited **in conjunction with a physical structure**, such as a computer memory, USPTO personnel should treat the claim as a **product claim**.⁴ Moreover, “[a]n element in a claim for a combination may be expressed as a **means or step for** performing a specified function **without the recital of structure**, material, or acts in support thereof, and such claim **shall** be construed to cover the **corresponding structure**, material, or acts described in the specification and equivalents thereof.”⁵

Applicants’ specification states that “[t]he file sharing client 101 is preferably realized as a personal **computer** on which file sharing **software** 201 is running,”⁶ and describes “slow” computers as including “computers with limited . . . **processing power** . . . ”⁷ A processor is a physical structure, and a computer having a processor is a physical structure. The file sharing software is therefore described as corresponding to a physical structure. Accordingly, Applicants’ specification recites corresponding structure to perform the functions recited in claim 3. The claimed elements of claim 3 are thus recited in conjunction with a physical structure. As a result, claim 3 and its dependent claims 7-9 should be treated as product claims, as instructed by the MPEP. Thus, Applicants respectfully request that these rejections be reconsidered and withdrawn and that the claims be allowed.

The Office Action asserted that independent claim 14 is directed to a device comprising only modules” and that “the claimed device may be reasonably considered as a **software** device,

² Office Action, page 3, emphasis added.

³ MPEP 2106.01(I), third paragraph, emphasis added.

⁴ MPEP 2106.01(I), fourth paragraph, emphasis added.

⁵ 35 U.S.C. § 112, sixth paragraph, emphasis added.

⁶ Specification, paragraph 0033, emphasis added.

⁷ *Id.* at paragraph 0025, emphasis added.

and a software device does not meet one of the four categories of invention and not statutory.”⁸

Claim 14 is amended herein to recite, in part, “the fingerprinting module being implemented using a **processor**.” Support for this amendment may be found in Applicants’ specification, for example, at paragraphs 0025 and 0033. As noted above, a processor is a physical structure, and the claimed elements of claim 14 are therefore recited in conjunction with a physical structure. As a result, claim 14 and its dependent claims 15-17 should be treated as product claims, as instructed by the MPEP.

Moreover, Applicants assert that independent claim 14 is statutory, at least because it is directed to a machine. Under recent instructions issued by the Office, a machine “includes every mechanical device or a combination of mechanical powers and devices to perform some function and produce a certain effect or result.”⁹ A computer is a mechanical device and therefore a machine. Claim 14 recites a computer to implement the fingerprinting module. As result, claim 14 and its dependent claims 15-17 are directed to a machine. Thus, Applicants respectfully request that these rejections be reconsidered and withdrawn and that the claims be allowed.

§ 102 Rejections of the Claims

Claim 1 was rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Levy et al. (US Publication #2007/0294173, hereinafter “Levy ‘173”). To anticipate a claim, a reference must disclose **each and every element** of the claim,¹⁰ as arranged in the claim,¹¹ and in as

⁸ Office Action, pages 3-4, emphasis added, discussing previously canceled claim “13.” To facilitate prosecution of this application, Applicants presume that this is a typographical error and that the Examiner intended to discuss independent claim 14.

⁹ Interim Examination Instructions for Evaluating Subject Matter Eligibility under 35 U.S.C. § 101, page 5 (August 24, 2009).

¹⁰ “A claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed Cir. 1987), emphasis added.

¹¹ It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, **arranged as in the claim**.” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 U.S.P.Q. 193 (Fed. Cir. 1983), emphasis added.

complete detail as in the claim.¹² Applicants respectfully submit that the cited reference does not establish a *prima facie* case of anticipation, because the cited reference fails to disclose each and every claimed element of Applicants' subject matter, as arranged in the claims, and in as complete detail as in the claims.¹³

Independent claim 1 is amended herein to recite, in part, "**computing a fingerprint for least a portion of the multimedia object file to obtain an identifier for the multimedia object file**," which is also recited in claim 3 and previously examined with respect to claim 3. In discussing this element, the Office Action stated that Levy '173 "does not specifically teach of the identifying means comprising a fingerprint calculator to obtain the identifier by computing a fingerprint for at least a portion of the multimedia object file"¹⁴ Applicants agree that Levy '173 fails to disclose at least this element. As a result, the cited reference does not disclose **computing a fingerprint** for least a portion of the multimedia object file to obtain an identifier for the multimedia object file, as recited in the context of claim 1. Moreover, the deficiencies of Levy '173 are not cured by Levy (US Pub. No. 2002/0052885, hereinafter "Levy '885"), as discussed below.

Furthermore, independent claim 1 is amended herein for clarity to recite, in part, "**transmitting the registered usage information from the device to a billing server to bill a user account . . . by a first amount . . . ; and transmitting the recorded user profile from the device to the billing server to credit the user account by a second amount.**"¹⁵ Support for these claimed elements may be found in Applicants' specification, for example, at paragraphs 0045-0046¹⁶ and 0052.¹⁷ Accordingly, in an example embodiment, a user may be charged by an associated

¹² "The identical invention must be shown **in as complete detail** as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); MPEP § 2131; emphasis added.

¹³ "[T]he exclusion of a claimed element from a prior art reference is enough to negate anticipation by that reference." *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 771-72, 218 U.S.P.Q. 781, 789 (Fed Cir. 1983).

¹⁴ Office Action, page 6.

¹⁵ Claim 1, emphasis added.

¹⁶ Specification, paragraphs 0045-0046, "registered usage information serves as the basis for afterwards billing [A] reporting module transmits the recorded data to the third party to allow afterwards billing for sharing of the multimedia object in accordance with the registered usage information," reference numerals omitted.

¹⁷ *Id.* at paragraph 0052, "To provide an incentive for the user to supply his user profile information, he could be credited on the bill . . . for the sharing of the multimedia objects. The reporting module is now arranged to . . . transmit at least a portion of the user profile to the third party," reference numerals omitted.

amount for sharing a multimedia object (e.g., each time the object is shared), but may be rewarded for sharing user information such as browsing information by crediting that user with associated amount. Nothing in Levy '173 mentions **billing and crediting** the same user account. As a result, Levy '173 fails to disclose at least these elements. Additionally, Applicants are unable to find any discussion of these claimed elements in the art of record.

Because **each and every element** of independent claim 1 is not disclosed in the cited reference, as arranged in the claims, and in as complete detail as in the claims, no *prima facie* case of anticipation has been established. For at least these reasons, independent claim 1 and its dependent claims 18-21, added herein, are patentable over the cited reference. Moreover, the dependent claims may each be patentable based on elements recited therein. Thus, Applicants respectfully request that this rejection be reconsidered and withdrawn and that the claims be allowed.

§ 103 Rejections of the Claims

Claims 3, 8, 11, 14, and 16 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Levy '173, in view of Levy '885, Ishibashi (US Patent No. 7,353,541), and Horvitz et al. (US Pub No. 2004/0076936, hereinafter "Horvitz"). A determination of obviousness requires a factual showing that "the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains."¹⁸

Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined.¹⁹

Applicants respectfully submit that a determination of obviousness is not established for the reason that the scope and content of the cited references, even if combined, do not teach or

¹⁸ *Graham v. John Deere*, 383 U.S. 1, 17, 148 U.S.P.Q. 459, 467 (1966).

¹⁹ *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 82 U.S.P.Q.2d 1385 (2007).

suggest all claimed elements or support rational inferences that one skilled in the art reasonably would be expected to draw to reach all claimed elements.

Moreover, the “Patent and Trademark Office (PTO) must consider **all claim limitations** when determining patentability of an invention over the prior art.”²⁰ When determining whether a claim is obvious, an examiner must make “a searching comparison of the claimed invention – including **all its limitations** – with the teaching of the prior art.”²¹ Thus, “obviousness requires a suggestion of **all limitations** in a claim.”²²

Applicants respectfully submit this requirement has not been met with respect to each of independent claims 3 and 14, at least because each of independent claims 3 and 14 recites, in part, “**transmit[ting] [the] registered usage information . . . [when] the registered usage information [meets] a predetermined criterion.**” The Office Action cited paragraphs 0057 and 0061 of Levy ‘173 as disclosing this element.²³ Levy ‘173, however, actually fails to disclose this element.

Paragraph 0057 of Levy ‘173, in relevant part, merely states that “[u]sage is preferably reported to the reporting system **according to the unique identifiers.**”²⁴ A unique identifier is neither a **predetermined criterion** nor any functional equivalent thereof. Hence, reporting usage according to unique identifiers is not functionally equivalent to transmitting registered usage information **when the registered usage information meets a predetermined criterion.**

Paragraph 0061 of Levy ‘173 discusses that “[t]he player **reports the usage . . .** to the central router database (or alternatively to the VOD operator B database).”²⁵ Nothing in the cited paragraph mentions a predetermined criterion or any functional equivalent thereof. Merely

²⁰ *In re Lowry*, 32 F.3d 1579, 1582 (Fed. Cir. 1994), emphasis added.

²¹ *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995), emphasis added; *see also Ex Parte Wada and Murphy*, Appeal No. 2007-3733 (B.P.A.I. 2008).

²² *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003), citing *In re Royka*, 490 F.2d 981, 985 (CCPA 1974), emphasis added; *see also Ex Parte Wada and Murphy*, Appeal No. 2007-3733 (B.P.A.I. 2008).

²³ Office Action, page 6.

²⁴ Levy, paragraph 0057, emphasis added.

²⁵ *Id.* at paragraph 0061.

stating that a player reports usage does not inherently disclose **transmitting registered usage information when the registered usage information meets a predetermined criterion**. As a result, the cited paragraphs of Levy '173 are silent with respect to this element. The remainder of Levy '173 likewise fails to mention this element. Thus, Levy '173 does not disclose this element.

Furthermore, Levy '885, Ishibashi, and Horvitz fail to cure the deficiencies of Levy '173, for at least the reason that there is no mention of a **predetermined criterion**, or any functional equivalent thereof, within any of Levy '885, Ishibashi, or Horvitz. Thus, none of the cited references discloses transmitting registered usage information when the registered usage information meets a predetermined criterion, as claimed in the context of the claims 3 and 14.

For at least these reasons, the scope and content of Levy '173, Levy '885, Ishibashi, and Horvitz, even if combined, do not disclose or suggest all claimed elements or support rational inferences that one skilled in the art reasonably would be expected to draw to reach all claimed elements. As a result, a determination of obviousness is not established with respect to any of independent claims 3 and 14, and their respective dependent claims, including claims 7-9, 11, and 15-17. Moreover, the dependent claims may each be patentable based on limitations recited therein. Thus, Applicants respectfully request that these rejections be reconsidered and withdrawn and that the claims be allowed.

Claims 7 and 15 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Levy '173, Levy '885, Ishibashi, and Horvitz, in view of Sako et al. (US Patent No. 7,062,467, hereinafter "Sako"). As discussed above, the scope and content of Levy '173, Levy '885, Ishibashi, and Horvitz, even if combined, do not disclose or suggest all claimed elements of independent claims 3 and 14, from which claims 7 and 15 respectively depend. Sako fails to cure the deficiencies of Levy '173, Levy '885, Ishibashi, and Horvitz. As a result, claims 7 and 15 are patentable over the combination of Levy '173, Levy '885, Ishibashi, Horvitz, and Sako. Thus, Applicants respectfully request that these rejections be reconsidered and withdrawn and that the claims be allowed.

Claims 9 and 17 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Levy '173, Levy '885, Ishibashi, and Horvitz, in view of Kutaragi et al. (US Patent No. 7,275,261, hereinafter "Kutaragi"). As discussed above, the scope and content of Levy '173, Levy '885, Ishibashi, and Horvitz, even if combined, do not disclose or suggest all claimed elements of independent claims 3 and 14, from which claims 9 and 17 respectively depend. Kutaragi fails to cure the deficiencies of Levy '173, Levy '885, Ishibashi, and Horvitz. As a result, claims 9 and 17 are patentable over the combination of Levy '173, Levy '885, Ishibashi, Horvitz, and Kutaragi. Thus, Applicants respectfully request that these rejections be reconsidered and withdrawn and that the claims be allowed.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone the undersigned at (408) 278-4048 to facilitate prosecution of this application.

If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.

Respectfully submitted,

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.
P.O. Box 2938
Minneapolis, MN 55402--0938
(408) 278-4048

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By /

Joseph J. Wang
Reg. No. 61,123



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John D. Gustav-Wrathall

Name

Signature

